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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,967	03/27/2001	Klaus Lowack	GR 00 P 1582	9883

7590

05/16/2002

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EXAMINER

LAM, CATHY FONG FONG

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 05/16/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

12-9

# Office Action Summary

Application No.

09/817,967

Applicant(s)

LOWACK ET AL.

Examiner

Cathy Lam

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

Art Unit: 1775

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 11-15, drawn to a component, classified in class 428, subclass 209.
  - II. Claims 16-23, drawn to a process for producing a component, classified in class 427, subclass 96+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a different process such as by spin coating a dielectric material over a substrate then spin coating a second dielectric over the first dielectric, then sensitize the second dielectric layer for metallization. The process as claimed can be used to make a different product such as a multilayer decorative article.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Atty: Mark Weichselbaum on March 12<sup>th</sup> 2002 a provisional election was made without traverse to prosecute the invention of group I, claims 11-15. Affirmation of this election must be made by applicant in replying

to this Office action. Claims 16-23 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. Claims 11, 12, 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, it is vague and indefinite as to what "surface functionalization that is other than metallization, photosensitization....." is referring to?

In claim 12, it is vague and indefinite as to what "electronic component" and "microelectronic component" are referring to?

Claim 14 is indefinite as the phrase "at least one said upper layer" should be -- at least said one upper layer --. Also, it is unclear the phrase "..... for activating said lower layer" is referring to? Clarification is required.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 11-12 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Leuschner et al (US 5556812).

Art Unit: 1775

Due to some claims are unclear, with respect to the prior art rejections below, the claims will be given the broadest possible interpretation in view of the specification.

Leuschner discloses a multichip module comprised of a non-conductive substrate, a plurality of dielectric layers and conductive metal tracks (col 4 L 57-62).

A (first) dielectric material is formed over the substrate, a resist material is formed over the dielectric material in order to prepare a surface on the dielectric material for metallization. Followed by a seed layer and a conductive material to form a conductive tracks (col 7 L 34-47). A second dielectric material is formed over the (first) dielectric material, a (2<sup>nd</sup>) resist is formed over the 2<sup>nd</sup> dielectric material and is to prepare for a next metallization (col 7 L 48-59).

The dielectric material are both polybenzoxazole material and have a thickness of 9  $\mu\text{m}$  (col 8 L 10-16 & L 53-54).

***Allowable Subject Matter***

8. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy Lam whose telephone number is (703) 308-2418. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Art Unit: 1775

872-9604 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Cathy Lam  
Primary Examiner  
Art Unit 1775

cfl  
May 14, 2002